

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN M. ADAMS, HOA PHAM and DANIEL LUCH

Appeal No. 2005-2294
Application No. 09/375,164

ON BRIEF

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 28 in this application for the reissue of U.S. Patent No. 5,687,865. This is a broadening reissue and was filed within two years of the patent issue date of November 18, 1997. Claims 1 through 28 are all of the claims pending in the application.

As noted in column 1 of the specification, appellants' invention is generally directed to a new and improved cap for a fluid container which is formed with a conical well which splits when pierced by a dispenser probe and substantially recloses when disengaged from the probe. More particularly, the invention relates to a plastic snap-on cap for a bottle neck having a crown finish either with or without a superimposed thread finish which is tamper-evident and includes a spill reduction feature. A preferred embodiment of appellants' fluid container cap is shown in Figures 2-5 of the application, wherein it is noted that the cap (21) includes, *inter alia*, a circular top (22) and a skirt depending from the top, a central conical well (46) formed in the top (22) and having an internal scoreline (51). The scoreline (51) is said to consist of a first stretch (52) extending from adjacent the top downwardly and merging with a second stretch (53) which extends across the bottom (48) of the well and then merges with another upward stretch (54). The stretches (52, 53, 54) lie in a common diametric plane. On the exterior side of the bottom (48) is a rib (56) arranged perpendicular to the plane of scoreline (51).

In the paragraphs spanning columns 4 and 5 of the specification, the operation of appellants' cap is described in the following manner:

"[t]he container with cap 21 in place on neck 11 is inverted and installed in the dispenser by vertical downward movement. The dispenser has a hollow, apertured probe 61 extending vertically upwardly. As the bottle lowers, the tip 62 of probe 61 encounters rib 56 and then bottom 48 causing the well 46 to split along internal scoreline 51 until the position of Fig. 5 is obtained. Water enters probe 61 and flows into the dispenser as required.

After the contents of the bottle have been substantially depleted, the bottle is removed by lifting vertically upwardly. The two halves of the well 46 shown in Fig. 5 come together by reason of the resiliency of the plastic material of which the cap is molded. The well 46 is not restored to its original condition but substantial leakage is inhibited so that spillage of water onto the outside of the dispenser and/or floor is avoided."

Appellants' invention is also directed to a combination container neck and cap of the type discussed above (see, e.g., claims 7 and 19) and to a combination involving a hollow, apertured probe having a blunt tip, a container and a cap of the type discussed above (claim 26). Claims 1, 7, 19 and 26 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix A of appellants' brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Steidley et al. (Steidley) 4,022,258 May 10, 1977

Claims 1 through 28 stand rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought.

Claims 1 through 28 also stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the original application was filed, had possession of the now claimed invention.

Claims 1 through 26 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Claims 1, 2, 5, 9, 15 and 16 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Steidley.¹

Rather than reiterate the examiner's full position set forth concerning the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (mailed November 5, 2002) for the examiner's complete reasoning in support of the rejections remaining on appeal, and to appellants' amended brief (filed April 6, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given

¹ In light of the examiner's comments in the advisory actions mailed October 30, 2002 and May 5, 2004, we are of the view that the rejections as set forth above are all of the rejections remaining for our review in this appeal. We also make note of the "Supplemental Declaration for Reissue Patent Application" filed June 16, 2004, which declaration should be reviewed and treated by the examiner during any further prosecution of this application.

careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Since the examiner's rejections of claims 1 through 28 under 35 U.S.C. § 251 and 35 U.S.C. § 112, first paragraph, both hinge on essentially the same added subject matter and line of reasoning, we will consider them together. In the examiner's view the disclosure of appellants' patent provides support for only one scoreline extending along the side wall and across the bottom of the central well (46), and does not provide support for either a plurality of scorelines or a scoreline positioned only on the bottom of the well. Thus, the examiner contends that the recitation in claims 1 and 26 on appeal of "at least one scoreline positioned on said bottom" of the central well has introduced new matter into the reissue application in violation of the proscription in 35 U.S.C. § 251 and also runs afoul of the written description requirement of 35 U.S.C. § 112, first paragraph. We do not agree.

In the present case, appellants have indicated that, through error and without any deceptive intention, the original patent was inoperative or invalid by reason of the patentees claiming less than they had a right to claim. More particularly, appellants urge that they had a right to broadly claim a cap having a well and a scoreline positioned on the bottom of the well as opposed to claiming a cap having a well and a scoreline that extended down a portion of the side wall, across the bottom of the well and up another portion of the side wall. In support of that position, appellants contend that the recitation of "a scoreline" in open-ended "comprising" claim 1 of the patent already covers one or more scorelines, that the disclosure of a preferred or exemplary embodiment encompassing a singular element such as the scoreline (51) of Figures 2-4 of the patent does not in any way disclaim a plural embodiment, and that the claims of the reissue application are generic to and supported by an embodiment of the invention that is disclosed in the original patent and supported by the application as originally filed.

For the reasons aptly set forth by appellants' on pages 9-18 of their amended brief, we wholeheartedly agree with appellants' position. The mere finding by the examiner that the now claimed

subject matter of the reissue application was not originally claimed, not an express object of the original patent, and not depicted in the drawings of the patent is simply not enough by itself to establish that the new claims in the reissue application are not drawn to the invention disclosed in the original patent, or that such claims necessarily include new matter. In our view, the disclosure of appellants' patent, considered as a whole, evidences that 1) the patentees could have claimed the subject matter now set forth in the reissue application in the patent, and 2) there is nothing in the original patent specification which indicates an intent not to claim the present subject matter. Moreover, we share appellants' view that one of ordinary skill in the art, reading the patent specification, would have recognized that the subject matter of the now disputed claims in the reissue application was invented and disclosed by the patentees, notwithstanding that the preferred embodiment shown and described in the patent was somewhat more restrictive than the subject matter now claimed.

Thus, we will not sustain either the rejection of claims 1 through 28 under 35 U.S.C. § 251 or under 35 U.S.C. § 112, first paragraph.

The next rejection for our review is that of claims 1 through 26 under 35 U.S.C. § 112, second paragraph. Essentially, this rejection is based on the examiner's belief that claims 1 through 26 fail to correspond in scope to that which applicants regard as their invention because the applicants have argued during the prosecution of this application that U.S. Patent No. 4,022,258 to Steidley does not anticipate the claimed invention. More particularly, the examiner premises this rejection on the mistaken conclusion that the side wall of the well as defined in the claims on appeal is "identical to the disclosed structure of the Steidley closure" (answer, page 4). Like appellants, and for the reasons clearly set forth on pages 20-24 of the amended brief, we find the examiner's position to be in error. Thus, the rejection of claims 1 through 26 under 35 U.S.C. § 112, second paragraph, will not be sustained.²

² As for any concern the examiner may have that applicants' failed to sufficiently claim the structure of the central well such that the claimed function of "only a probe with a blunt tip will engage the bottom at a center thereof" (answer, page 4), we observe that no such limitation is present in the claims on appeal. Moreover, we agree with appellants' comments set forth on pages 18-20 of the amended brief.

The last of the examiner's rejections on appeal is that of claims 1, 2, 5, 9, 15 and 16 under 35 U.S.C. § 102(b) as being anticipated by Steidley. In this instance, the examiner has determined that Steidley teaches a closure and connector therefor comprising a resilient plastic cap (10) with a top (13), a skirt (12) with screw threads, and a central well (14) with a conical side wall (18), a rounded bottom, and a scoreline (15a). However, for the reasons clearly set forth on pages 24-29 of the amended brief, we find that Steidley does not anticipate the subject matter of the above-enumerated claims.

More specifically, it is clear to us that Steidley does not disclose, teach or suggest a cap as defined in claim 1 on appeal including a central well having at least one scoreline positioned on a bottom thereof and a side wall formed to cause a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said well, and wherein the at least one scoreline is positioned such that the blunt tip of the probe splits the well's bottom along the at least one scoreline as the blunt tip of the probe is forced against the center of the bottom so that the probe may enter the container neck. Thus, for at least this reason, the rejection of claims 1, 2, 5, 9, 15 and 16 under

35 U.S.C. § 102(b) as being anticipated by Steidley will not be sustained.

To summarize our decision, we have refused to sustain the examiner's rejection of claims 1 through 28 under either 35 U.S.C. § 251 or 35 U.S.C. § 112, first paragraph. We have also refused to sustain the rejection of claims 1 through 26 under 35 U.S.C. § 112, second paragraph. In addition, we will not sustain the examiner's rejection of claims 1, 2, 5, 9, 15 and 16 under 35 U.S.C. § 102(b).

REVERSED

JENNIFER D. BAHR
Administrative Patent Judge

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